

REMARKS/ARGUMENTS

This is a preliminary amendment in a RCE Application. The Office Action mailed 05/08/2003 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested.

35 USC 112 Rejections

In numbered paragraph 6, claims 1-6 were rejected under 35 USC 112, second paragraph.

In numbered paragraph 6 a) claim 1, the Examiner stated, "it is not clear whether the interdigitated electrodes (electrodes with projecting legs) of the fifth paragraph of the claim are the same as the electrodes with projecting legs of the seventh paragraph of the claim." The rejected claim 1 has been amended to clarify that the interdigitated electrodes (electrodes with projecting legs) of the fifth paragraph of the claim are the same as the electrodes with projecting legs of the seventh paragraph. Applicants believe this amendment of claim 1 overcomes the 35 USC 112 issue raised by the Examiner regarding claim 1.

In numbered paragraph 6 b) claim 3, the Examiner stated, "it is not clear whether the interdigitated electrodes (electrodes with projecting legs) of the fourth paragraph of the claim are the same as the electrodes with projecting legs of the sixth paragraph of the claim." The rejected claim 3 has been amended to clarify that the interdigitated electrodes (electrodes with projecting legs) of the fourth paragraph of the claim are the same as the electrodes with projecting legs of the sixth paragraph. Applicants believe this amendment of claim 3 overcomes the 35 USC 112 issue raised by the Examiner regarding claim 3.

In numbered paragraph 6c) claim 6, line 6, the Examiner stated, "the first occurrence of "electrode" should be replaced with - - second - -." The rejected claim 6 has been amended to replace the first occurrence of "electrode" with - - second - -. Applicants believe this amendment of claim 6, line 6, overcomes the 35 USC 112 issue raised by the Examiner regarding claim 6, line 6.

In numbered paragraph 6d) claim 6, the Examiner stated, "the sweeping and applying steps appear incompatible. How can the AC voltage sweep particles through the microchannel and trap them at the same time?" The rejected claim 6 has been amended to clarify that the step includes "sweeping said particles down said fluidic microchannel and trapping said particles." This amendment is supported in the specification on page 4, lines 15-16 and page 5, lines 16-17. Applicants believe this amendment of claim 6 overcomes the 35 USC 112 issue raised by the Examiner regarding this portion of claim 6.

35 USC 102 Rejection

In numbered paragraph 9, claims 1, 3, 5, and 6 were rejected under 35 USC 102(a) as allegedly anticipated by Morishima et al ("Novel Separation Method on a Chip Using Capillary Electrophoresis in Combination with Dielectrophoresis," Micro Total Analysis Systems 2000, 269-272, May 14-18, 2000).

Applicants respectfully submit that the Morishima et al reference is not a valid reference against the subject application. The publication date of the Morishima et al reference is May 14-18, 2000, which is only seven (7) months prior to the December 8, 2000 filing date of the subject application. The information in the Morishima et al reference was therefore not described in a printed publication more than one year prior to the filing date of the subject application as required by 35 USC 102(a).

35 USC 103 Rejection - McBride et al in view of Becker et al

In numbered paragraph 13 claims 1-6 were rejected under 35 USC 103(a) as being allegedly being unpatentable over McBride et al (US 6,296,752) in view of Becker et al (US 6,287,832). Enclosed is a declaration by the inventors Robin R. Miles, Kerry A. Bettencourt, and Christopher K. Fuller and a declaration by Eddie E. Scott. These two declarations establish that Applicants made the invention described and claimed in the subject patent application in this country prior to June 4, 1999 which is the filing date of the application from which The McBride et al Reference, United States Patent No. 6,296,752 issued. Applicants submit that The Cited McBride et al Reference, United States Patent No. 6,296,752, can not be used as a reference against the claims of the subject application. Since the McBride et al Reference, United States Patent No. 6,296,752, can not be used as a reference against the claims of the subject application the cited references do not render the claimed invention unpatentable.

35 USC 103 Rejection - McBride et al in view of Becker et al

In numbered paragraph 14 claims 2 and 4 were rejected under 35 USC 103(a) as being allegedly being unpatentable over Morishima et al in view of Bakewell et al. Applicants respectfully submit that the Morishima et al reference is not a valid reference against the subject application. The publication date of the Morishima et al reference is May 14-18, 2000, which is only seven (7) months prior to the December 8, 2000 filing date of the subject application. Since the Morishima et al reference fails, the rejection of claims 2 and 4 under 35 USC 103(a) as being allegedly being unpatentable over Morishima et al in view of Bakewell et al also fails.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments, the enclosed declarations, and the foregoing remarks, the rejections of the claims raised in the Office Action dated May 8, 2003 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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Dated: July 18, 2003